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EXAMINER				
LEFT, STEVEN N				
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1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/752,898

Applicant(s)

BUCHANAN, BRETT J.

Examiner

STEVEN LEFF

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13,15,16,19,21-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,13,15,16,19,21-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

Regarding applicant's declaration and the testimonials provided which speak to the novelty of the applicant's invention, it is noted that these statements amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

It further states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04 where applicant has provided statistical data and relies upon statements which amount to an affirmation that the affiant has never seen the claimed subject matter before. However, this is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - Claim 5 is rejected due to the phrase "the cat" as it lacks antecedent basis and therefore it is unclear if "the cat" is with respect to "the animal" of independent claim 1, or with respect to only a cat being able to access the edible material by biting or clawing the shell.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 1, 2, 5-10, 13, 19, 21-23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (4260635) in view of Smith (1022113).

Fisher teaches an animal food toy that is shaped and includes multiple layers of edible materials encased by a shell for oral interaction with the animal (col. 4 line 11). The edible layers can be made of food components such as those animal foods currently used and known and are preferably in a dry, shelf-stable form such as dried meats, dried fish, fish meal, fish flour, cereals, fruits, etc., with or without food additives or supplements such as vitamins, minerals, medicinals, etc (col. 4 lines 11-24), where at least one underlying layer comprises multiple layers of a plurality of different edible materials (col. 3 lines 25-28, col. 9 lines 22-24). The layered product could employ as many layers as desired with the combinations herein being infinite such as 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, or more layers (col. 9 lines 22-24), where the outside layer can be viewed as the shell. Each layer may or may not include safely ingestible structure supporting fibers (abstract), where the binding material releases layer materials upon penetration (col. 4 lines 9-11) and the layers may be formed concentrically around a core by dipping the core repeatedly in rawhide or collagen fiber containing pet food (col. 2 lines 61-65), where the binding agent provides a time release property (col. 4 line 11).

In addition, the pet food can be built up to yield a product with different thickness layers, where the chew-resistance or hardness of the product could be a function of “the pressure employed in compacting the product” (col.2 line 25). With respect to claim 13 it is noted that all of the layers are edible thus positively teaching the inner edible material in the form of one or more edible objects.

Fisher continues by teaching that the shell maintains freshness of underlying layers (col. 4 lines 12-25), which gradually wears away (col. 1 lines 60-62) so as to release inner edible material upon penetration (col. 4 lines 1-10). With respect to claim 21 it is noted that the homogeneous mixture is taken with respect to figures 1 and 2, as the shell houses, and encases the mixture within. Further with respect to figure 1, Fisher positively teaches the edible material exhibiting a marbling effect (inner core labeled hard), and that the shell includes at least one edible nodule.

Fisher however is silent with respect to specifically teaching the toy for a cat, and that the edible material further includes catnip.

Smith teaches a “device in the form of a ball because a toy of such shape is easier for a cat to play with...” (pg. 2 col. 1 lines 7-9) Smith further teaches the “ball could be made either partially or entirely of a catnip compound,” (pg. 1 col. 1 line 49+) and “may include an exterior coating of the catnip compound,” (pg.1 col. 2 line 87+) “so that the cat may always be able to get the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+).

Therefore since Fisher teaches that the entire toy may be consumed, and further since Fisher teaches the addition of any known additives (col. 4 lines 21-24) for enticing the animal it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included catnip in a toy specific for a cat, in the animal toy of Fisher, since both Fisher and Smith teach the positive solution of entertaining an animal by producing a toy that includes flavor agents, or inducements and since Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines 19-24) where Smith positively teaches catnip for its art recognized and applicants purpose of enticing a cat.

It would have further been obvious to one of ordinary skill in the art at the time of the invention by the applicant, since Smith specifically teaches the toy with respect to enticing a cat due to the catnip (pg. 1 lines 10-16), where providing a specific single edible material which is known in the art would be merely a matter of obvious choice

which is dependent upon the specific animal which the toy is made for, where MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. In the instant case, Fisher teaches an edible pet toy comprised of “known food” (col. 4 lines 19-24) where Smith positively teaches catnip for its art recognized and applicants purpose of enticing a cat, and thus since all the claimed elements were known in the prior art and one skilled in the art could have substituted the elements with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the two methods, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their having been individually taught in the prior art (see MPEP 2144.06) with respect to specific animals such as cats and dogs.

- Claims 1, 2, 5, 10, 13, 15, 16, 21-23, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baikie (6238715) in view of Smith (1022113).

Baikie teaches an animal food that is shaped and includes edible materials encased by a shell for oral interaction with the animal by biting (col. 1 lines 40-52). More specifically the underlying layer formed of the edible material comprises a binding material that provides consistency to retain form (col. 2 lines 40-53, col. 3 lines 16-24), where the binding materials release the layer material upon penetration (col. 2 lines 27-31). In addition the edible material includes an inducement (col. 2 lines 20-25), that the binding agent provides consistency and rigidity thereby resulting in a time release property (col. 2 lines 27-31), where the edible material is a gel or a paste which is released through one or more holes in the shell (fig. 1, col. 3 lines 8-9) such that distortion causes the inner edible material to be released (col. 2 lines 27-31).

In addition, Baikie teaches mixing the edible material and binding material into a homogeneous mixture of an inducement and at least one of a nutrient or a treatment (col. 2 lines 40-53), forming an outer shell for housing the homogeneous mixture (col. 2 lines 6-64), and encasing the edible material within the shell (col. 3 lines 6-9), where the edible material can be replaced through a hole in the outer shell (col. 3 lines 6-8).

Baikie however is silent with respect to specifically teaching the toy for a cat, and that the edible material further includes catnip.

Smith teaches a “device in the form of a ball because a toy of such shape is easier for a cat to play with...” (pg. 2 col. 1 lines 7-9) Smith further teaches the “ball could be made either partially or entirely of a catnip compound,” (pg. 1 col. 1 line 49+) and “may include an exterior coating of the catnip compound,” (pg.1 col. 2 line 87+) “so that the cat may always be able to get the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+).

Therefore since Baikie teaches that the entire toy may be consumed, and further since Baikie teaches the addition any number of flavors such as peanut butter, or bacon (col. 4 lines 5-7) for enticing the animal, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have included catnip in a toy specific for a cat, in the animal toy of Baikie, since both Baikie and Smith teach the positive solution of entertaining an animal by producing a toy that includes flavor agents, or inducements and since Baikie teaches an edible pet toy comprised a component which is specific to initially attracting the animals attention and maintaining this attraction (col. 2 lines 19-25) where Smith positively teaches catnip for its art recognized and applicants purpose of enticing a cat.

It would have further been obvious to one of ordinary skill in the art at the time of the invention by the applicant, since Smith specifically teaches the toy with respect to enticing a cat due to the catnip (pg. 1 lines 10-16), where providing a specific single edible material which is known in the art would be merely a matter of obvious choice which is dependent upon the specific animal which the toy is made for, where MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. In the instant case, Baikie teaches an edible pet toy comprised of a component which is specific to initially attracting the animals attention and maintaining this attraction (col. 2 lines 19-25), where Smith positively teaches catnip for its art recognized and applicants purpose of enticing a cat, and thus since all the claimed elements were known in the prior art and one skilled in the art could have substituted the elements with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention where combining the two methods, each of which is taught by the prior art to be useful for the same purpose of enticing animals to a toy, flows logically from their

having been individually taught in the prior art (see MPEP 2144.06) with respect to specific animals such as cats and dogs.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's arguments against Smith it is noted that although Smith does not teach the inner layers being completely edible, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), and thus while Smith does not disclose all the features of the present claimed invention, Smith is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely that the use of catnip in cat toys is conventional and in combination with the primary reference, discloses the presently claimed invention.

Regarding applicant's declaration and the testimonials provided which speak to the novelty of the applicant's invention, it is noted that these statement amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN LEFF whose telephone number is (571)272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Drew E Becker/

Primary Examiner, Art Unit 1794

/Steven Leff/

Examiner, Art Unit 1794